

REMARKS

Claims 2-11, 13 and 14 are pending in this application. By this Amendment, claims 2-11, 13 and 14 are amended and claims 1, 12, 15-35 and 38-75 are canceled. Claims 2-11 and 13 are amended to depend from amended independent claim 14.

No new matter is added to the present application by this Amendment. Support for the new features added to claim 14 find support in canceled claim 1, as originally filed, in present Examples 1-5 and within the present specification, as originally filed, at, for example, paragraphs [0070], [0073], [0076] and [0093] of U.S. Patent Publication No. 2006/0180797 for the present application.

Entry of the amendments is proper under 37 CFR 1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments and reconsideration of the application are thus respectfully requested.

I. Rejection Under 35 USC 103

Claims 1-14 were rejected under 35 USC 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0077450 to Kirchmeyer et al. (hereinafter “Kirchmeyer”) or U.S. Patent No. 7,112,368 to Hsu in view of U.S. Patent No. 5,886,046 to Nishiyama et al. (hereinafter “Nishiyama”). This rejection is respectfully traversed.

Prior to discussing the merits of the Examiner's position, the undersigned reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). There must be some suggestion, teaching, or motivation arising from what the prior art would have taught a person of ordinary skill in the field of the invention to make the proposed changes to the reference. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). But see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re*

Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."

In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The Patent Office alleges that the combination of Kirchmeyer and Nishiyama or the combination Hsu and Nishiyama teach or suggest each and every feature of the foregoing claims.

In view of the cancellation of claim 1, this rejection is moot with respect to that claim.

Amended independent claim 14 is directed to a process requiring (1) preparing an oxidant by treating a metal salt of an organic acid or an inorganic acid having organic radicals with an ion exchanger and (2) mixing the oxidant with at least one precursor for preparing at least one conductive polymer.

As acknowledged by the Patent Office, both Kirchmyer and Hsu, at best, are considered to suggest a process for preparing an oxidant wherein an organic acid metal salt or inorganic acid metal salt having organic radicals is treated with an ion exchanger (see page 5 of the present Office Action). Moreover, the combination of Kirchmeyer, Hsu and Nishiyama, at best, show that iron (III)-containing oxidant may be used in preparation of conductive polymer as acknowledged by the Patent Office (see page 5 of the present Office Action).

In the present Office Action, the Patent Office alleges that claim 1 as presently on file is not inventive over either Kirchmeyer or Hsu in view of Nishiyama because the feature "*to prepare said metal salt as an oxidant before said metal salt is brought into contact with precursors as an oxidant for said preparation of said conductive polymers*" does not limit the process for preparing an oxidant and does not give such feature "a *patentable weight*" (see the

paragraph bridging pages 3 and 4 of the Office Action).

However, those allegations by the Patent Office certainly do not apply for amended claim 14 because amended claim 14 is not directed to a process for preparing an oxidant, but instead is directed to a process for the oxidative polymerization of precursors for the preparation of conductive polymers. This process is characterized by the features: (1) preparing an oxidant by treating a metal salt of an organic acid or an inorganic acid having organic radicals with an ion exchanger; and (2) mixing the oxidant with at least one precursor for preparing at least one conductive polymer. According to the process of claim 14, Applicants submit that the feature “*preparing an oxidant by treating a metal salt of an organic acid or an inorganic acid having organic radicals with an ion exchanger*” and “*mixing the oxidant with at least one precursor for preparing at least one conductive polymer*” distinguishes the present process from the teachings of Kirchmeyer, Nishiyama and/or Hsu.

According to the teaching of Kirchmeyer, ion exchangers are added to the reaction mixture obtained when polymerizing the EDT-precursors for the purpose of purification (see paragraph [0048] in Kirchmeyer) and Hsu also teaches to add ion exchangers to the reaction mixture (i.e. “*the product of the polymerization reaction*”, see line 51 in column 3 of Hsu) for the purpose of quenching the polymerization and removing the metal ions (see column 3, lines 56-60 in Hsu *et al.*), Thus, Kirchmeyer and Hsu teach a skilled artisan that ion exchange resins can be used after the polymerisation reaction in order to quench the polymerization reaction in the sense of finally terminating the reaction after formation of the polymers and to purify the reaction mixture. For this reason, both, Kirchmeyer and Hsu, add the ion exchange resins after the conductive polymer has been formed. As the resins are only used

for finally terminating the reaction after formation of the polymers and for the purification of the reaction mixture, there would have been no reason for a skilled artisan to add the ion exchange resins to the oxidant before it is brought into contact with the precursors.

Thus, Kirchmeyer and Nishiyama or Hsu and Nishiyama, taken singly or in combination, do not teach or suggest (1) preparing an oxidant by treating a metal salt of an organic acid or an inorganic acid having organic radicals with an ion exchanger and (2) mixing the oxidant with at least one precursor for preparing at least one conductive polymer as required by amended claim 14.

Because these features of independent claim 14 are neither taught nor suggested by Kirchmeyer or Hsu in view of Nishiyama, the combinations of these references would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 2-11, 13 and 14 are patentably distinct from and/or non-obvious in view of Kirchmeyer and Nishiyama or Hsu and Nishiyama. Reconsideration and withdrawal of the rejections of the claims under 35 USC 103(a) are respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 2-11, 13 and 14 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By /Brian C. Anscomb/
Brian C. Anscomb
Reg. No. 48,641
875 Third Avenue, 8th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844